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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

LY, NGHI H

ART UNIT	PAPER NUMBER
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2686

DATE MAILED: 04/13/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,284

Applicant(s)

CAO ET AL.

Examiner

Nghi H. Ly

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-15,17-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-15,17-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>15</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 and 29 have been amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 6-8, 11-13, 17, 18, 21-23 and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Iyengar et al (US 6,546,241).

Regarding claims 6, 18 and 27, Iyengar teaches a cordless phone (see abstract) comprising: connecting a base unit of the cordless telephone to a public switch telephone network (PSTN) (fig.1, see the connection between base unit 107 and network 100), and playing MP3 music from a remote handset of ~~the~~ cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Regarding claim 7, Iyengar further teaches the MP3 music is pre-loaded before the step of playing (see column 5, lines 23-27, see "then upload according to the invention to the handset 109").

Regarding claim 8, Iyengar teaches the music is played substantially real-time as it is received by the cordless telephone (see column 1, lines 40-54).

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Regarding claims 11 and 21, Iyengar further teaches downloading digital bit stream music comprised in an MPEG format to the remote handset directly from a remote bit stream audio source (see column 5, lines 23-27, see "then upload according to the invention to the handset 109").

Regarding claims 12 and 22, Iyengar further teaches the method of integrating an MPEG audio player in a cordless telephone and downloading digital bit stream music comprised in an MPEG format in a base unit of the cordless telephone (see column 1, line 65 to column 2, line 20).

Regarding claims 13 and 23, Iyengar further teaches storing the downloaded digital bit stream music comprised in an MPEG format in the remote handset (see column 5, lines 23-27, see "then upload according to the invention to the handset 109").

Regarding claim 17, Iyengar further teaches the MPEG format in and MP3 format (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the

various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 2, 4, 5 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Rydbeck (WO 99/43136).

Regarding claims 1 and 29, Iyengar teaches a cordless telephone (see Abstract), comprising: a remote handset (see fig. 1, handset 109), a base unit matched to the remote handset (see fig. 1, handset 107), and an MPEG audio player integrated within at least one of the remote handset and the base unit (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer 3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Iyengar does not specifically disclose the remote handset can switch between performing as a telephony device and performing as audio player.

Rydbeck teaches the remote handset can switch between performing as a telephony device and performing as audio player (see page 7, lines 2-4).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck into the system of Iyengar in order to prevent telephone conversation from interfering with audio sounds.

Regarding claim 2, Iyengar further teaches the MPEG audio player is integrated within the remote handset (column 5, lines 13-27, see "to the handset 109").

Regarding claims 4 and 5, Iyengar further teaches the MPEG audio player is an MP3 (column 5, lines 23-27, see "MP3").

7. Claims 14, 15, 24, 25, 28 are rejected under 35 U.S.C 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Rostoker (US 6,035,212).

Regarding claims 14 and 24, Iyengar teaches the apparatus for integrating an MPEG audio player in a cordless telephone (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25). Iyengar does not specifically disclose the downloaded digital bit, stream music comprised in an MPEG format is stored in Flash memory in the remote handset.

Rostoker teaches the downloaded digital bit, stream music comprised in an MPEG format is stored in Flash memory in the remote handset (see column 9, line 29-31).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostoker into the system of Iyengar in order to prevent data lost.

Regarding claims 15 and 25, the combination of Iyengar and Rostocker further teaches the remote bit stream audio source is accessible by the remote handset via an Internet (see Rostocker, column 13, lines 20-24).

Regarding claim 28, the combination of Iyengar and Rostocker further teaches decompressing MPEG formatted music into digital music samples for digital to analog output (see Rostoker, column 10, lines 45-52 and see column 14, lines 1-27).

8. Claims 9, 10, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iyengar et al (US 6,546,241) in view of Wingate (US 6,006,115).

Regarding claims 9, 10, 19 and 20, Iyengar teaches the method of integrating an MPEG audio player in a cordless telephone and playing of the pre-loaded MP3 music. Iyengar does not specifically disclose muting the playing of the pre-loaded MP3 music when the remote handset is active in a current telephone call (see column 5, lines 13-27, Iyengar teaches MP3 or MPEG audio layer3 or MP3 is an abbreviation of MPEG audio layer 3) (also see column 1, lines 21-25).

Wingate teaches muting the playing of the music when the remote handset is active in a current telephone call (see column 4, lines 29-39).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wingate into the system of Iyengar so that the user won't miss the telephone call while enjoy listening to music.

Response to Arguments

9. Applicant's arguments with respect to claims 1, 2, 4-15, 17-25 and 27-29 have been considered but are moot in view of the new ground(s) of rejection.

In light of Applicant's amendment (regarding claim 29) with respect to the rejection under 112, first paragraph, the examiner hereby withdraws the rejection under 112, first paragraph as stated in the previous action.

On page 8 of Applicant's remarks (dated 02/09/04), Applicant argues that Rostocker teaches a cellular telephone and the cellular telephone is not a remote handset of a cordless telephone.

In response, the Rostocker's cellular telephone and the Applicant's cordless telephone both are communication devices, and those skilled in the art would appreciated that the teaching of Rostocker can also be used in the cordless telephone without changing the scope and spirit of Rostocker's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rostocker, in order to decompressing MPEG formatted music into digital music samples for digital to analog output (see Rostoker column 14, lines 1-27), so that more audio data can be downloaded to the user.

On page 9 of Applicant's remarks, Applicant further argues that Rydbeck teaches a cellular telephone and the cellular telephone is not a remote handset of a cordless telephone.

In response, the Rydbeck's cellular telephone and the Applicant's cordless telephone both are communication devices, and those skilled in the art would appreciated that the teaching of Rydbeck can also be used in the cordless telephone without changing the scope and spirit of Rydbeck's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Rydbeck, in order to prevent telephone conversation from interfering with audio sounds and the user can enjoy listening to audio sounds from a cordless telephone.

On page 13 of Applicant's remarks, Applicant further argues that Wingate teaches a wireless telephone and the wireless telephone is not a remote handset of a cordless telephone.

In response, the Wingate's wireless telephone and the Applicant's cordless telephone both are communication devices, and those skilled in the art would appreciated that the teaching of Wingate can also be used in the cordless telephone without changing the scope and spirit of Wingate's invention.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teaching of Wingate into a cordless telephone, so that the user won't miss the telephone call while enjoy listening to music.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nghi H. Ly whose telephone number is (703) 605-5164. The examiner can normally be reached on 8:30 am-5:30 pm Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on (703) 305-4379. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Nghi H. Ly

NH Ly
24/07/04

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